IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marcus Wong

Serial No.: 09/827,226 Examiner: Shifcraw, Eleni A.

Filed: April 5, 2001 Group Art Unit: 2136

Title: SYSTEM AND METHOD FOR PROVIDING SECURE COMMUNICATIONS BETWEEN WIRELESS UNITS USING A COMMON KEY

REQUEST FOR RECONSIDERATION

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is responsive to the Office Action mailed on August 10, 2005. Applicant respectfully requests reconsideration of this application.

Applicant respectfully traverses the rejections under 35 U.S.C. §103 based upon the proposed combination of *Johnston, Terao, et al.*, and *Ellison*. There is no *prima facie* case of obviousness.

A proposed combination cannot be made where it goes directly contrary to the teachings of the primary reference. A proposed modification to the primary reference cannot defeat an intended operation or remove an intended feature of the teachings of that reference. In this instance, the Examiner's proposed combination undoes one of the stated goals of the *Johnston* reference. The Examiner proposes adding a "common key" from *Terao, et al.* into the *Johnston* arrangement. This is directly contrary to the intention of *Johnston's* teachings.

At column 3, lines 36-42, *Johnston* teaches that it wants to avoid having more than one of the mobile terminals knowing the key of the other terminal(s). In particular, *Johnston* states, "Thus in accordance with the invention, each terminal is provided with a partial key from the remote location that includes masked data concerning the terminal key of the terminal itself, without the need for the key of the other terminal." *Johnston*, therefore, wants to avoid a common key. Instead, *Johnston* relies upon using different keys at each of the terminals to maintain security of the keys.

Therefore, there is no motivation for making the substitution proposed by the Examiner. It goes directly contrary to the intentions of the *Johnston* reference and the combination cannot be made.

Another reason why there is no motivation to combine is that *Terao, et al.* use a common key for co-owned, similarly located devices. That is not the type of arrangement contemplated in *Johnston*. One dealing with a system like *Johnston* would not look to the teachings of *Terao, et al.* because they are used in different contexts. Applicant's disclosure cannot be used as a basis for a word search to extract a term from a reference to plug into another. The teachings of the references must be considered. The combination cannot be made.

The proposed addition of the teachings of *Ellison* does not remedy the defect preventing the combination of *Johnston* and *Terao, et al.* Further, *Ellison* is concerned with secure communication between a computer and another hardware device, neither of which appears to be a wireless communication device.

There is no motivation for making the proposed combination and no *prima facie* case of obviousness. None of the claims can be considered obvious on that basis.

Further, even if the combination could somehow be made, the result is not the same as what is claimed in many of Applicant's claims. If one were to substitute in the common key from *Terao, et al.* into the *Johnston* arrangement, the result would not be the same as any of claims 2-20. *Terao, et al.* pre-store the common key in devices that are sold together as a single set to a single user. Paragraph 138, lines 1 and 2, and paragraph 140, lines 1-6 in *Terao, et al.* indicate this. Therefore, even if one substituted in the pre-stored common key of *Terao, et al.* into the *Johnston* arrangement (which cannot be done as discussed above), that would not be the same as performing at least one of the steps from each of claims 2-20 so that there is no *prima facie* case of obviousness against those claims.

One cannot modify the teachings of *Terao, et al.* using the teachings of *Ellison* in an attempt to somehow render the combination the same as Applicant's claims. Doing so would be contrary to the teachings of the *Terao, et al.* reference and there is no motivation for making such a substitution. Further, such a layered modification of references could only be the result of hindsight reasoning based upon Applicant's own disclosure and claims. There is nothing within the references that suggests the combination proposed by the Examiner. Even if the combination could somehow be made, the result is not the same as Applicant's claims.

This case is in condition for allowance.

Respectfully submitted,

Dated: October 11, 2005

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By: _____

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CERTIFICATE OF FACSIMILE

I hereby certify that this Request for Reconsideration, relative to Application No. 09/827,226 is being facsimile transmitted to the United States Patent and Trademark Office, (703) 872-9306, on October 11, 2005.

Theresa M. Palmateer

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